

REMARKS

The Office Action has rejected Claims 43-53 as being obvious over a combination of *Shoff et al.* (U.S. Patent No. 6,240,555) in view of *Allibhoy et al.* (U.S. Patent No. 5,818,440) under 35 U.S.C. §103.

The Office Action is relying upon the teachings of the *Shoff et al.* reference to disclose an interactive entertainment system that permits the presentation of supplemental interactive content along with a traditional broadcast video program.

As noted in the discussion of the Background of the Invention in the *Shoff et al.* disclosure, the problem recognized was the presentation of material wherein separate panels independently presented the information and that the providers would not have control over both the television program and the interactive supplemental content as it was presented to the viewer. The solution suggested in Column 3, Lines 14-52 was to provide an electron program guide (EPG) data field containing a pointer or other target specification for accessing the supplemental content which could be transmitted or combined at the set top box. Layout instructions could be obtained from a target resource for the actual display of both the video content and the supplemental content, thereby providing a content developer with a tool for integrating the information.

As can be appreciated, this is a relatively crowded field and recognizing the problems that are addressed can offer insight into the issue of obviousness when making combinations of references under a 35 U.S.C. §101 rejection.

“Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light.”

Continental Can Co. USA Inc. v. Monsanto Co., 20 U.S.P.Q. 2d. 1746,
1752 (Fed. Cir. 1991).

Independent Claims 43, and 53 have now been amended to incorporate the disclosures found, for example, in Figure 8 content 2100, content 2130, content 2200 and the content 2300, along with the navigation information 2160 shown in Figure 11 and the supporting information in the specification. For example, the present invention's capability of setting filtering conditions and enabling link information updating to thereby provide valid period information for content display.

Thus, it is possible to realize a data display control information editing apparatus which generates control information that has a specified operation executed at a specified time by data display control information received in a digital broadcast.

As can be appreciated, control information called "time __ event" instead of navigation information as shown, for example, in Figure 9, is provided. Accordingly, when the time given in the time event portion is reached, control is performed to execute a specific operation. See, for example, the teachings set forth on Pages 67-81. As can be appreciated, the control information includes link information for indicating at least one of the other contents before the time specified by the time control information.

A display control unit, when judging an instruction should be executed, can change the display of the currently displayed content by executing the instruction and execute an instruction specified by handler information included in the MPEG-2 transport stream in direct responses to the performance of one of the interactive operations by a user. Thus, a dynamic interface with a user is provided. As can be appreciated, our reception control unit 1050 can appropriately

visualize or remove the visualization corresponding buttons that are available for activation by the user.

In the Office Action rejection, basically the *Allibhoy et al.* reference was relied upon to teach in Column 5, Line 24, the capacity of having an MPEG-2 decompression unit for implementing an inclusion of short-term commercial advertisement displays with interactive content feature. Actually, the *Allibhoy et al.* reference is attempting to solve a problem that occurs, not so much for the user, but to the advertiser that wishes to force advertising content into the display of the desired content to the user. In this regard, implementing application programs are imposed on the set top computing system automatically so that a plurality of viewer choices do not have to be selected by activating icons as set forth in the prior art, but are automatically imposed on the user so that a selected application will interact with the user until a positive quit response from the user is detected.

The problem addressed was to fully impose on the viewer all the interactive options or button features that the advertiser (not the viewer) wants to have presented during the short advertisement time period, and not rely upon the viewer to avail themselves of such options at the viewer's own choice. The *Allibhoy et al.* reference does not direct or teach the operation of a display control unit as defined in our current claims.

Thus, one highly relevant inquiry in making an evaluation under 35 U.S.C. §103 is "[t]he relationship between the problem which the inventor. . . was attempting to solve and the problem to which any prior art reference is directed." *Stanley Works v. McKinney Mfg. Co.*, 216 USPQ, 298, 304 (Del. D.C. 1981). Thus, in analyzing the prior art under Section 103 of the Act, we must clearly comprehend the problem addressed by the present inventors and that problem must be compared or contrasted, as the case may be, with the problems addressed by the prior art.

The Office Action actually relied upon Column 10, Lines 18-58, to purportedly teach the link information implementing the performance of interactive operations by a user. Actually, this portion of the specification suggested multiple sources of signals can be received by the viewer computing unit and regardless of the manner in which it is delivered, the digital data can be deconstructed to extract timing information and the manner in which the display of the video content and any supplemental information will be presented on the screen.

It is this latter feature which is the problem addressed in the *Shoff et al.* disclosure.

Thus, the video data can be scaled or changed in size, style or location or other parameters to accommodate the supplemental content. The actual specifics and the advantages of the present invention are certainly not taught nor suggested in the cited portions of the *Shoff et al.* reference.

It is appreciated that the currently amended claims provide additional distinguishing features over the art considered by the Examiner in the First Office Action. It is believed, however, that the *Allibhoy et al.* reference was simply cited for the presentation of an MPEG-2 data format, since it was clearly addressing a different problem, neither recognized nor addressed by the *Shoff et al.* disclosure.

Additionally, the *Shoff et al.* teaching presents a relatively higher level overview of combining a conventional content with the supplemental content over the same program signal. Any combination of these two references does not provide any reasoning or rational underpinning that would support a legal conclusion of obviousness.

The Federal Circuit has held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the

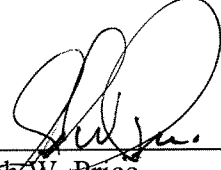
prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed.*” (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed.*” (emphasis added)).

In summary, it is believed that the present amended claims now more than adequately distinguish over any combination of the references of record, and an early indication of allowance is requested.

If the Examiner believes a telephone interview will help further the prosecution of this case, he is respectfully requested to contact the undersigned attorney at the listed phone number.

Very truly yours,

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